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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WATKINS III, WILLIAM P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,381

Applicant(s)

BOSTDORF, DAVID E.

Examiner

William P. Watkins III

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner has carefully reviewed applicant's explanation on the intent of the amendments to claims 1, 20 and 21 given on pages 16 and 17 of the response filed 03 May 2006. It appears that the intent of the amendments is to claim a stack of sheets as shown in instant Figures 1-3 where the slit structure in sheet 10a is offset one distance from the perimeter and the slit structure in sheet 10b is offset a different distance from the same edge and the sheets are stacked in a sequence of one sheet being sheet 10a, the next adjoining sheet being 10b, such that the slit patterns are offset from each other and do not align, and the next successive sheet after adjoining sheet 10b, being a duplicate of sheet 10a that is aligned and identical to sheet 10a, and the next successive sheet after said previous sheet, being identical and aligned with sheet 10b. In other words the pattern is 10a, 10b, 10a, 10b, 10a, 10b throughout the stack of the sheets.

The examiner agrees with applicant that this structure, as described by the examiner above, is taught away from by Haggerty with teaches a stack of four sheets with at least adjacent sheets having slits that are offset and a preference, as stated

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at col. 2, lines 15-20 of Haggerty, for the slits in any given sheet not to be aligned with the slits in any of the other sheets. This clearly teaches away from every other sheet having identical aligned slits. The reference would thus clearly not anticipate or render obvious such a slit structure in a stack of sheets if clearly claimed as explained above.

For the reasons given below in the 112 2nd paragraph rejections against claims 1-20, the examiner does not find such a structure to be clearly claimed in independent claims 1 and 20. The rejections using Haggerty are therefore maintained against these claims, as it is not clear that they distinguish over the reference. The above described offset die cut structure is clearly described in instant amended claim 21. As a result of the language in claim 21, the rejections using Haggerty have been withdrawn against claim 21 and the claims that depend from it. However, the examiner notes that in the course of amending claim 21, applicant has broadened the die cuts from being slit die cuts to being simple die cuts without limitation as to shape or configuration.

As the rejections using May, given in previous office actions, were withdrawn against claim 21 and the claims depending on claim 21, due to the introduction of the inboard

slit limitation, as noted in section 1 of the detailed portion of the office action mailed 20 March 2006, these rejections are reinstated below against the newly amended and broadened claims 21-25. In the interest of economy, discussion of applicant's arguments regarding Haggerty and the various claims that depend from claim 1, is deferred, pending resolution of the issues described in the 112 rejections given below.

2. Claims 1-12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states that the die cuts are offset in adjoining sheets, yet repeat identically in alternating sheets throughout the stack. Applicant's arguments state that the sheets alternate in a 10a, 10b, 10a pattern through out the stack. Thus alternate sheets would appear to be the adjoining pair of 10a and 10b. It is unclear how these sheets can have both identical and offset slits as required by the claim. Further it is unclear if the repeating die cuts of claims 4-6 are identical or offset, as the only repeating die cuts, that provide antecedent basis in instant claim 1, appear to be identical.

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Further, even if claim 1 is constructed according to applicant's arguments, it is not clear how claims 5 and 6 would further limit a so constructed claim. Regarding claim 20, it is unclear how the die cuts can be offset in adjoining sheets yet be identical in the next successive sheet, when said next successive sheet is itself an adjoining sheet. It is thus not clear how adjoining sheets can have the die cuts being both identical and offset.

3. Claims 10 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Reasons for the allowable subject matter are given in section 2 of the detailed portion of the office action mailed 04 April 2006.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-4, 7-9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Haggerty (U.S. 4,331,254).

See Figures 1, 2, and 3 which show a stack of sheets with slits that are offset from each other in adjacent layers. The slits are next to a circular opening which the examiner takes as being a type of diecut. Regarding the limitation of the stack being of stationery sheets, the examiner notes that there is not a specific definition of "stationary" given in the instant specification and that "stationary" is described in section 003 of the instant specification as being of many different types of sheets that vary in material composition and configuration. The examiner therefore takes the rubber or plastic sheets of the gasket material of Haggerty as capable of being used as stationary. The examiner further notes that the stack of gasket sheets is loose and is only temporarily held by the bolts of the reference.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

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differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5-6, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haggerty (U.S. 4,331,254).

Haggerty teaches the claimed slit structure as noted above. The reference teaches that it is preferable that adjacent sheets have slits that are offset from each other. The instant invention claims adjacent sheets that have offset slits and successive sheets with aligned slits, as well as slits that are offset an imperceptible amount in adjacent sheets. Variation in the arrangement of slits in nonadjacent sheets as well as the degree of offset in adjacent sheets is taken as being within the ordinary skill of the art as long as the teaching of adjacent sheet slits being offset as required by Haggerty is observed.

8. Claims 20-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by May (U.S. 5,447,299).

See Figure 3, which shows offset holes in different layers, which prevent jamming, as well as straight die cuts adjacent circular holes, and side folds on each side of the central area. The holes and straight die cuts on the edges appear to be

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identical in every other sheet in the stack as shown in Figure

3. The examiner does not give specific weight to the openings being die cut as it is not clear how hole formation by this means differs from hole formation by another means such as laser cutting.

9. Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admissions of a commercial product that holds key cards (paragraphs 005 and 009) and has die cuts and May (U.S. 5,447,299).

Applicant admits that a keycard holder configuration of silts in a folded sheet is in commercial use. May teaches offsets in openings in stacked sheets to allow entry of air and prevent jamming when printing various sheet products such as cards (col. 4, lines 45-65, col. 6, lines 45-55). The holes and straight die cuts on the edges appear to be identical in every other sheet in the stack as shown in Figure 3. The instant invention claims curved and straight cut areas in a sheet with a central portion and two side portions. It would have been obvious to one of skill in the art to have offset the openings in the stacks of the admitted cardholder of applicant in order to prevent jamming when feeding the sheets into various

processing machines. The degree of offset between features in alternating layers being within the ordinary skill of the art absent unexpected results.

10. Applicant's arguments filed 03 May 2006 have been fully considered but they are not persuasive.

Applicant's arguments have been treated in the first section of the office action above.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William P. Watkins III

**WILLIAM P. WATKINS III
PRIMARY EXAMINER**

WW/ww

July 9, 2006